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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,688	01/09/2001	Richard L. Fisher	Fisher-001221	4670

7590 04/22/2003

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EXAMINER

AVILA, STEPHEN P

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No. 09/756,688	Applicant(s) FISHER, RICHARD L.	
	Examiner Stephen Avila	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 and 38-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-31 and 38-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 21-31, 38, and 39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Foreman (6,361,388; newly cited). Foreman discloses a drive assembly for a marine motor with an elongate drive tube, a drive assembly, a bearing, and a seal.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-31, 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, the specification does not clearly provide a marine mud motor (100 in figure 1 does not specifically set forth a mud motor; page 2, lines 12-18 refers to a mud boat, not a mud motor), a drive tube that includes a drive assembly housing (while a drive tube 140 and a housing 200 is shown it is not clear where it is disclosed that the drive tube includes the housing), a bearing, in rotational communication between the drive assembly housing and the drive shaft (page 10, lines 12, 13 does not clearly state that the

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bearings are in rotational communication with the drive assembly housing), and a seal configured to restrict contaminants from entering the drive assembly housing (page 9, last line-page 10, first line refers to water, but there appears to be no disclosure as to restricting contaminants), as claimed. Also not clearly disclosed in the specification:

The drive tube and the drive assembly housing are an integral unit (page 11, lines 6, 7 refers to the drive tube and the bearing housing 210 being integral, not the drive tube and the drive assembly housing). The housing inside diameter being larger than the inside diameter of the drive tube (figure 3 does not show the inside diameter of the drive tube and page 11, lines 2-3 does not refer to the inside diameter of the drive tube). The bearing having an outside diameter greater than the inside diameter of the drive tube (page 11, lines 2, 3) does not refer to the drive tube.

4. Claims 40-52 and 63-71 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lovell. Lovell discloses a marine propulsion system having a rotary drive shaft 16, a casing 22, bearings 40, a housing 12, a removable cover 62, and a seal 75.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 53-62 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lovell in view of Hulsebus et al (cited by Applicant).

Lovell does not disclose ball bearings. Hulsebus et al teach ball bearings 15, 34 to reduce friction. It would have been an obvious choice of engineering design to a person of ordinary skill in the art at the time the invention was made to form the bearings of Lovell in the form of ball bearings with races as taught by Hulsebus et al for improved shaft movement and reduced friction.

7. With respect to the affidavits and article filed 8/13/02 and 11/25/02 there appears to be no supporting details as to all of the limitations of the claims 21-31. Applicant has not shown that the Applicant is prima facie entitled to a judgment relative to the patentee under 37 CFR 1.608 (b). No demonstration has been made that that Applicant would be entitled to a judgment against the patentee on ground of unpatentability, for example by prior public use or prior art. It appears that the publications filed 8/13/02 and 11/25/02 would not be able to meet the patented claims 21-31. MPEP 2308.02.

8. Applicant's arguments filed 11/25/02 have been fully considered but they are not persuasive. Applicant alleges that Lovell does not disclose a bearing structure. However, to the contrary Lovell teaches a bearing structure 40.

Applicant further alleges that Lovell is unsuitable for mud motors. However, claims 40-72 do not set forth any limitations requiring a mud motor. Only limitations claimed may be relied upon for patentability.

With respect to the ball bearings claimed in claims 53-62 and 72, Hulsebus et al clearly teaches ball bearings 14, 34 for reduced friction. Such a combination would have a been obvious to a person of ordinary skill in the art of shafting and drive systems. Such a person of ordinary skill in the art would be very familiar with all types

of bearings and in particular ball bearing and would find the combination to have been obvious.

Applicant alleges that the elements of claims 21-31 and 38-39 are interchangeable. However, the statements in the affidavits are self serving statements. Note that no evidence other than the statements has been presented.

With respect to the arguments with respect to the details of claims 21-31, the Examiner maintains the position set forth in paragraph 3, above.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

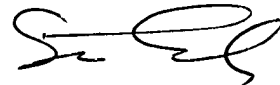
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Avila whose telephone number is 703-308-

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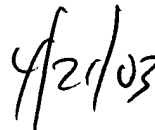
2578. The examiner can normally be reached on Monday to Thursday from 8 AM to 4 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Stephen Avila
Primary Examiner
Art Unit 3617



April 21, 2003